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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,888	01/10/2002	Jonas L. Steinman	I02.004	6273

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EXAMINER	
RATHINASAMY, PALANI P	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/043,888	STEINMAN ET AL.	
	Examiner	Art Unit	
	Palani P. Rathinasamy	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,8,10,13-15,20,22,23, 25-29,32,34,35,37,38,41,43-45,56 and 57* is/are pending in the application.

4a) Of the above claim(s) *1-5,7,8 and 25-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10,13-15,20,22-23,28,29,32,34,35,37,38,41,43-45,56 and 57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/27/2002, 4/24/2002, 01/10/2003.

Detailed Action

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-5, 7, 8, and 25-27, are drawn to serving an electronic version of a print advertisement, classified in class 705, subclass 14.

   II. Claims 10, 13-15, 20, 22-23, 28, 29, 32, 34, 35, 37, 38, 41,43-45, 56 and 57, are drawn to serving advertisements on multiple windows/web pages, classified in class 705, subclass 14.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions 1 and 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination (invention 1) does not require multiple pages/windows. The subcombination (invention 2) has separate utility such as it is useful for serving other ads that are not electronic versions of print advertisements.

3. During a telephone conversation with Stephen De Klerk on October 13, 2006 a provisional election was made without traverse to prosecute the invention of II, claims 10, 13-15, 20, 22-23, 28, 29, 32, 34, 35, 37, 38, 41, 43-45, 56 and 57. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5, 7,

8, and 25-27 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention lacks patentable utility. An invention must provide a useful, concrete and tangible result in order to be patentable. Claim 23 is rejected as lacking usefulness as they are missing the necessary step of serving the advertisement.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10, 13-15, 20, 22-23, 28, 29, 32, 34, 35, 37, 38, 56 and 57 are rejected as being unclear to the examiner. Regarding independent claims 10, 22-23, 28, 32, and 37, applicant teaches of displaying a advertisement on at "least one of a window or Web page" followed by serving another advertisement on at "least one of a window or Web page." It is unclear to the examiner if the applicant intends for this second advertisement to be displayed on a new window or in the same window as the first advertisement. Applicant is required to amend claims to resolve this ambiguity. Claims

13-15, 20, 29, 34, 35, 38, 56 and 57 are likewise rejected as being dependent on an unclear independent claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10, 13, 14, 22-23, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (US 5,848,397). Marsh et al. teaches of a method for continuously changing advertisements displayed in a web browser.

9. Regarding claims 10, 22 – 23, applicant teaches of displaying a small form and a large form of an advertisement on a web-browser. Marsh et al. shows an example where a small version of an advertisement is displayed on the top of a browser and the full version is displayed underneath [Fig 4].

10. Regarding claim 13, 14 and 57, applicant teaches of asking the user if they would like to view the advertisement and then receiving information from the user if they want to view the ad. Marsh et al. teaches of advertisements that the user "clicks to receive additional information" [Summary of the Invention, col 4, lines 32-37]. Providing a clickable advertisement is an indication of an opportunity to view. By clicking on the advertisement, the user gives notice of desire to view. Regarding claim 14, applicant teaches of "requesting confirmation" that the user viewed the advertisement. The user clicking on the advertisement is confirmation that they viewed the advertisement.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 15, 20, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (US 5,848,397).

13. Regarding claim 15, 56, applicant teaches that the confirmation is displayed for a fixed period of time. Marsh et al. teaches that it is common for advertisements and windows being shown for a "certain period of time" [Background of the Invention, col 2, lines 22-34]. It would have been obvious to one skilled in the art to use Marsh et al.'s advertisements with a fixed display time.

14. Regarding claim 20, applicant teaches that the advertisement is "scrolled". OFFICIAL NOTICE is taken that a browser window being scrolled is an option that is available to the user to which the advertisement is displayed. It would have been obvious for a user to scroll advertisements displayed in Marsh et al.'s system.

15. Claims 28, 29, 32, 34, 35, 37, 38, 41, 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (US 5,848,397) in view of JAVA SCRIPT programming ("Java Script", Ready, 1996 New Riders Publishing). JAVA

SCRIPT teaches coding methods for creating interactive web sites and is a standard method for creating advertisements in web domains.

16. Regarding claims 28, 29, 32, 34, 37, 38, 41 and 43, applicant teaches of displaying advertisements where the first advertisement is not resizable by the viewer. JAVA SCRIPT is a standard method for creating interactive web pages that display, amongst other things, advertisements (see figures on page 33). In JAVA SCRIPT coding, the switch "resizable" controls "whether the window can be resized" [JAVA SCRIPT, page 32]. Therefore it would have been obvious to one skilled in the art to display Marsh et al.'s advertisements using JAVA SCRIPT and prevent the advertisement window from being resized. Regarding claim 43, applicant teaches that the window has a "fixed size". A window that is not resizable is therefore fixed in size. Regarding claims 28, 32, 37 and 41, applicant teaches that the first advertisement is not viewable because it is covered by the second advertisement. JAVA SCRIPT gives an example of an advertisement that prevents another advertisement by being on top [Figure 2.10, pg 33]. It would have been obvious to one skilled in the art to display Marsh et al.'s advertisements using JAVA SCRIPT such that one advertisement was not visible.

17. Regarding claim 35, 44, 45, applicant teaches that the advertisement is displayed full screen when it is displayed. In JAVA SCRIPT coding, the variable "width" and "height" control the size the window as it is displayed [JAVA SCRIPT, page 32]. The book also teaches of how to display windows that are in "full screen" mode [JAVA SCRIPT, page 33]. Therefore it would have been obvious to one skilled in the art to

display the advertisement using JAVA SCRIPT and make the advertisement window full screen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PPR

JEFFREY D. CARLSON
PRIMARY EXAMINER